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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,705	06/30/2000	Shinji Yoshimura	44243P	6865

2292 7590 12/21/2001

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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 12/21/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

MF-5

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-3 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-3 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☒ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4 ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

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1. The Examiner notes that applicant has submitted an IDS which cites two Japanese patent documents, which, however have to date not been entered into the application file. The Examiner has been able to obtain an Abstract of JP 09255926A. However, Japanese Patent U62-129043 has not been provided to the application file in any form and so the Examiner has been unable to make it of record. Applicants are urged to remedy this situation if at all possible with their next response. Finally, the Examiner further notes that the two Japanese documents cited on page 1, lines 27 and 28 of the specification have not been entered into the examination file as well, since the Examiner has been unable to obtain a suitable English language equivalent or Abstract of either. Abstracts of the first document JP -383 were obtained, but had nothing to do with the subject matter of the present invention and the Examiner questions the number of this document.

2. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, the claims contain

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several vague and indefinite phrases which possibly may be due to translation related errors and should be corrected. Phrases objected to are "ring-like body", "sheet-like material", "merely flat shape" in claim 1 and "something" in claim 3 line 3. Claim 2 should be revised to include proper Markush language.

4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either JP -926 Abstract or Kao et al. The references each disclose, in certain embodiments (note particularly JP -926, the Abstract; Kao et al., Figure 1, column 1 lines 12-21, column 2 lines 34-36, column 5 lines 41-48) adhesive tapes having an adhesive layer coated onto one side of a ~~suitable~~ tape which is wrapped around a substantially flat core structure that is, however, hollow (i.e. "ring like"), which is substantially all that applicant's broadest claim requires. The thickness limitation of 10-100 microns is believed to be, if not inherent, an obvious optimization parameter to one of ordinary

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skill. Note that although Kao et al. is relied upon substantially for its disclosure of the prior art, it clearly teaches such a core (e.g. column 2 lines 35-36). With respect to the print limitations of claim 3, this is believed to be both an obvious parameter to one of ordinary skill, as well as being broadly discussed at column 5 lines 41-43 of Kao et al. Other parameters that are not either expressly or inherently disclosed are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Snell, Watanabe, Taylor, and Spatorico et al.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

December 14, 2001

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900-
1700

Daniel Zinker